UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,702	12/29/1999	EVAN HOWARD LOTT		1341

24987 7590 06/10/2002

MARCUS G THEODORE, PC
466 SOUTH 500 EAST
SALT LAKE CITY, UT 84102

EXAMINER
CHANCE, JANET D

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 06/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/473,702	Applicant(s) LOTT, EVAN HOWARD
	Examiner Janet D. Chance	Art Unit 3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 December 1999* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☒ Interview Summary (PTO-413) Paper No(s). 5 .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 29 December 1999. Claims 1-11 are pending.

Drawings

2. The drawings are objected to because Figure 5 is not legible. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

> The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the U.S. Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Regarding claims 1-11, the phrase "such as" in claim 1, lines 3, 8, and 11, claim 9, lines 3, 8, and 11, and claim 10, lines 5, 10 and 13, renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). For purposes of applying art, Examiner interprets the claimed limitations to mean a database of information with data fields comprising those listed.

(B) The term "high degree of reliability" in claim 1, line 16, claim 9, line 16, and claim10, line 17 is a relative term that renders the claims indefinite. The term "high degree of reliability" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification gives no indication of the degree of reliability contemplated. Without such a disclosure undue experimentation would be required to perform the heuristic matching. For purposes of applying prior art, Examiner interprets the claimed limitations to mean computer processing by heuristic matching of non-corresponding sequences to generate a working database of uninsured motorists.

(C) The term "relevant information" in claim 1, lines 7 and 10, claim 9, lines 2, 7, and 10, and claim 10, line 4, 9, and 12 is a relative term that renders the claims indefinite. The term "relevant information" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification gives examples of appropriate data fields but does not distinctly claim those fields. Without such a disclosure undue experimentation would be required to determine the information included in the invention. For application of prior art, Examiner interprets the claimed limitations to mean a database of information with data fields comprising those listed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2, and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (U.S. Patent 5,325,291) in view of May et al. (May, Jerrold H. "A hybrid system improves claims auditing at Blue Cross", Interfaces, Providence, November/December 1993).

(A) As per claim 1, Garrett teaches a method of identifying uninsured motorists comprising:

(a) inputting (Garrett: col. 4, line 33) into a computer processor (Garrett: Figure 1, element 2000) a database of all in-force insurance policies with data fields comprising: name (Garrett: Figure 4 element 'name'), mailing address (Garrett: Figure 3, elements 'address', 'city', 'state', 'zip_code'), driver's license number (Garrett: Figure 4, element 420), date of birth (Garrett: Figure 4, element 'dob'), policy numbers (Garrett: Figure 4, element 450) and effective dates (Garrett: Figure 4, elements 'effective' and 'pol-expire'), make of vehicle (Garrett: Figure 4, element 'make'), year of vehicle (Garrett: Figure 4, element 'year'), type of vehicle (Garrett: Figure 4, element 'model') and vehicle identification number (Garrett: col. 1, lines 41-44 and Figure 4, element 410);

(b) inputting (Garrett: col. 1, line 33) into a computer processor (Garrett: Figure 1, element 2000) a database of driver information from the motor licensing division data fields comprising: driver's full name (Garrett: Figure 3, element 'name'), driver's license number, (Garrett: Figure 3, element 220), address (Garrett: Figure 3, elements 'address', 'city', 'state', and 'zip_code'), and date of birth (Garrett: col. 2 line 64-65, and Figure 3, element 'dob'). Further, Garrett discloses copying data fields into a separate holding area (Garrett: col. 3, lines 42-44). Garrett does not expressly disclose placing these data fields into a driver database. It would have been obvious to one of ordinary skill in the art at the time of the invention to separate these data fields into a driver database with the motivation of providing homogeneity of data sets and organizing data according to more accurate labeling.

(c) inputting (Garrett: col. 1, line 33) into a computer processor (Garrett: Figure 1, element 2000) a database of vehicle information ((Garrett: Figure 1, element 200), from the division of motor vehicles data fields comprising full name (Garrett: Figure 3, element 'name'), mailing address (Garrett: Figure 3, elements 'address', 'city', 'state' and 'zip_code'), vehicle

identification number (Garrett: Figure 3, element 210), and make (Garrett: Figure 3, element 'make'), and year of the vehicle (Garrett: col. 2 lines 53-58 and Figure 3, element 'year').

(d) computer processing the database to generate a database of uninsured motorists. (Garrett: col. 3, lines 26-30, 51-55 and 63-65). Garrett fails to disclose the specific type of computer processing method used to generate the uninsured database. May teaches the use of heuristics to assess insurance data (May: page 74, paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the heuristic method of May with the system of Garrett with the motivation of increasing the frequency of record transmission; reducing the time required for auditing information; and reducing errors in transmitted data (May: page 67, paragraph 1 lines 11-14).

(B) As per claim 2, the combined art of Garrett and May teach a method for identifying uninsured motorists as shown in the rejection of claim 1. However, Garrett and May do not specify any quantitative amounts. One having ordinary skill in the art at the time of the invention would have found it an obvious modification to utilize specific percentage quantities such as quantities of matching of 96 percent, quality of computer matches of 99 percent, and an overall system reliability of 95.8 percent, with the motivation of establishing a quantifiable threshold which yields an optimal solution set.

(C) As per Claim 4, Garrett discloses performing accuracy checks on the input databases and that various modifications can be employed to check other types of record information (Garrett: col. 5, lines 15-19). However, Garrett does not expressly disclose accuracy checks on the working database. It would have been obvious to one of ordinary skill in the art to check the

working database in addition to the input databases with the motivation of qualifying the most accurate resultant solutions set.

Further, Garrett does not expressly disclose statistic sampling as the specific accuracy checking method. May teaches statistically assessing claim data over time (May: page 76, col. 2 last sentence, and page 74, paragraph 1 and paragraph 2 sentence 1). It would have been obvious to one of ordinary skill in the art to combine the method of May and the system of Garrett for the same motivation given in the rejection of claim 1, and incorporated herein.

(D) As per Claim 5, Garrett discloses generating a list of uninsured motorists (Garrett: col. 4, line 68 to col. 5 line 1).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Garrett and May as applied to claim 1 above, and further in view of the New York State Department of Motor Vehicles (Anonymous, "Motor Vehicle Liability Insurance Reporting Implementation Guide", Version 1.0, 1 April 1999).

(A) As per claim 3, Garrett discloses computer identification of uninsured motorists and of notifying the authorities (Garrett: col. 4, line 68 to col. 5 line 3), computer identification of incomplete data (Garrett: col. 5, lines 4-9), pulling out those records and administratively correcting that data (Garrett: col. 5, lines 9-12). Garrett does not expressly disclose that the administrative handling comprises the transmission of notification to the source. The New York State Department of Motor Vehicles discloses transmitting the notification of incomplete data to the source (New York State Department of Motor Vehicles: page 8, section 6.0, paragraphs 2-3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the features of the New York State Department of Motor Vehicles and the system of Garrett with the motivation of creating and maintaining an up-to-date database of insurance information (New York State Department of Motor Vehicles: page 1, section 3.0, IIES goals, fifth bullet point).

7. Claims 6-7, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Garret and May as applied to claim 1 above, and further in view of Johnston (Johnston, Michelle Dally, "State targets scofflaw drivers Database to reveal who is uninsured", *Denver Post*, 16 December 1998).

(A) As per claim 6, Garret teaches a terminal having real-time access to the uninsured motorists database (Garrett: col. 5, lines 20-32). However Garrett and May do not teach that the terminal is remotely accessible by authorized personnel. Johnston teaches law enforcement agencies accessing the uninsured database (Johnston: second paragraph). It would have been obvious to use the features of Johnston in the system of Garrett and May with the motivation of aiding the enforcement of mandatory vehicular insurance laws (Johnston: paragraph 4, and paragraph 6 line 1).

(B) As per claim 7, Garrett and May disclose a method for identifying uninsured motorists. However, Garrett and May do not expressly disclose the mailing of notices requesting verification of insurance to the uninsured motorists. Johnson teaches the mailing of notifications requesting verification of insurance (Johnston: paragraph 13). It would be obvious for one of

ordinary skill in the art at the time of the invention to use the features of Johnston in the system of Garrett and May with the motivation of increasing the number of motorists carrying insurance (Johnston: paragraph 4).

Further, Garrett, discloses pulling records for administrative handling, correction, and reentry into the system (Garrett: col. 5, lines 9-12). However, Garrett, May and Johnston do not expressly disclose the data being updated came from the motorists. However, it would be obvious to one of ordinary skill in the art at the time of the invention to use the responses from the uninsured motorists to update the database with the motivation of having a more accurate database (Garrett: col. 2, lines 10-14).

(C) As per claim 9, claim 9 recites features disclosed in claims 1, 4, 5, 6, and 7, and is therefore rejected for the same reasons given for those claims, and incorporated herein.

(D) As per claim 10, the limitations of claim 10a-c differ from those in claims 1 and 5 in that, claims 1 and 5 contain a method recited as a series of function steps whereas the limitations in claim 10a-c contain features recited in a "means-plus-function" format. As the method steps of claims 1 and 5 have been shown to be disclosed or obvious by the combined teachings of Garrett and May, it is readily apparent that the "means" to accomplish those method steps is obvious in view of the listed citations of the prior art. As such, the limitations recited in claim 10a-c are rejected for the same reasons given above for the function claims 1 and 5 and incorporated herein.

Apparatus claim 10d differs from claim 6, in that claim 6 contains a method recited as a series of function steps whereas claim 10d contains features recited in a "means plus function"

format. As the method of step claim 6 has been shown to be disclosed or obvious by the combined teachings of Garrett, May, and Johnston, it is readily apparent that the "means" to accomplish those method steps is obvious in view of the prior art. As such, the limitations recited in claim 10d are rejected for the same reasons given for method claim 6 and incorporated herein.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Garrett and May as applied to claim 1 above, and further in view of Bosco et al. (U.S. Patent 5,191,522).

(A) As per claim 8, Garrett and May disclose a method for identifying uninsured motorists as written in the rejection of claim 1. Further Garrett discloses the generating of reports and transmitting those reports to a terminal (Garrett: col. 5, lines 20-32). However, Garrett and May do not expressly disclose the transmitting of report summaries outside of a closed system. Bosco discloses on-line access and transmission of reports outside of an insurance system (Bosco: col. 26, lines 35-38, and col. 27, lines 29-40). It would have been obvious to one of ordinary skill in the art to use the features of Bosco in the system of Garrett and May with the motivation of improving the ease of distribution (Bosco: col. 27, line 33).

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Garrett, May and Johnston as applied to claim 10 above, and further in view of Deppa (U.S. Patent 5,732,198). Garrett, May, and Johnston disclose an apparatus for listing uninsured motorists as explained in the rejection of claim 10. Further, Garrett discloses using the

uninsured database in further downstream processes that include notifying proper agencies (Garrett: col. 4, line 68 to col. 5, line 3). However, Garrett, May, and Johnston do not expressly disclose electronic signal transfer of coded signals to a translator that converts the coded electronic signals into printed reports. Deppa discloses electronic signal transfer (Deppa: Figure 1) of coded electronic signals (Deppa: col. 5, lines 4-8) from a computer (12) to a translator (printing device (14)) that converts the electronic signal into printed reports (Deppa: col. 9, lines 20-28). It would be obvious to one of ordinary skill in the art at the time of the invention to use the features of Deppa in the system of Garrett, May, and Johnston with the motivation of ensuring that output-ready data is available to a print engine as needed for efficient full page printing (Deppa: col. 1, lines 54-56).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a Department of Motor Vehicles which has an insurance verification program that identifies uninsured drivers and then the driver is sent a written request for proof of insurance (Sparks, Raymond L., "Mr. Sparks explains it all"); heuristic methods used for matching and producing high quality solutions (Holmberg Kaj, "An exact algorithm for the capacitated facility location problem with single sourcing"); and a system identifying uninsured motorists and those motorists receiving written notification of their uninsured status (Anonymous, "Nevada tries to check uninsured drivers").

11. **Any response to this action should be mailed to**:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703)746-7239 [Official communications]

(703)746-7238 [After Final communications, labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA, 4th floor receptionist.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet D. Chance whose telephone number is (703) 305-5356. The examiner can normally be reached on M-F 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

jdc
May 28, 2002

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600